

### **REMARKS**

Claims 4-7, 10, 14-16, 19 and 26 are original claims.

Claims 1-3, 8-9, 11-13, 17-18, 20-22, and 24-25 have been previously presented

Claims 23, 27-33 and 37 are currently amended.

Claims 34-36 have been canceled and the cancellation is without prejudice or waiver.

As the Examiner will appreciate this application is a *continuation-in-part* of allowed U.S. Ser. No. 09/603,885 filed June 26, 2000. As the Examiner is familiar with the subject matter, She will appreciate that the currently amended claims are additional species embodiments of the allowed claims wherein the reporter fragments are derived from a fluorescent protein.

### **THE RESTRICTION REQUIREMENT**

Applicants' respectfully request and urge the Examiner to examine the present application as a whole. Because of the new GATT rules, it is respectfully requested that this application be examined in its entirety, since it is not clear what the patent office's future policy will be regarding divisional practice, although recently the Patent Office has published that it is considering guidance for the Examiners on restrictions on biotechnology inventions.

Furthermore, given the climate on restriction practice, Applicants do not understand how the patent office continues to issue restriction requirements informing applicants that they have independent and distinct inventions. If the U.S. Patent and Trademark Office still insists on issuing restriction requirements, then applicant is entitled to 20 years for each divisional from the date of filing each divisional, not 20 years from the date of the original application. Applicants respectfully urge the Solicitor and law making officials to either abolish restriction practice or institute an

official policy of 20 years from filing for subsequently filed divisionals.

The restriction requirement is respectfully traversed. 35 USC 121 is permissive, not mandatory, and accordingly MPEP 808 requires not only clarification of the reasons why inventions as claimed are independent and distinct but also the reasons for insisting on restriction therebetween. Furthermore, the Commissioners notices appearing in 934 OG 2 and 922 OG 1016 urge examination of an entire application on the merits if this can be made without serious burden on the Examiner, even in cases which includes claims to distinct or independent inventions. Applicant believes that the entire invention as claimed can be examined without serious burden to the Examiner since the method is a fundamental part of all other aspects of the claimed subject matter and accordingly provides unity of invention. MPEP 800 specifically states that if the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

Also it is noted that the restriction requirement fails to state that the many inventions are independent and distinct, rather, only distinct.

If, the Patent and Trademark Office intends to divide the present application into a plurality of Examiner-determined inventions and restrict prosecution of the present application to one aspect of the subject matter which Applicant regards as his invention, equity requires that the factual basis for so holding be clearly delineated so that the record will reflect if such a requirement is proper under 35 USC 121.

The importance of the written record clearly setting forth the reasons upon which a restriction requirement is based, particularly with respect to claims to a compound or


composition held patentably distinct by the Patent and Trademark Office over method of use claims, is increasingly apparent from a brief filed by the Justice Department in U.S. v. Union Carbide Corp., an antitrust action in the U.S. District Court for Northern California seeking to invalidate U.S. Patent 3,009,855 on the insecticide "Sevin". In that case, the Patent and Trademark Office has insisted that the original application, claiming both a product and method of use, be restricted and merely alleged that the two constituted "distinct" inventions. Applicants retained product claims in the original application and canceled method claims which were presented in a divisional application. Some 20+ years later, the Justice Department argued in its brief that the restriction requirement was clearly not authorized under 35 USC 121, since the statute imposes the dual criteria that restrictable inventions must be both independent and distinct, stating in its brief:

...it is clear that the product carbaryl and its only disclosed use, e.g., killing insects, are not "independent and distinct" inventions. Since the first application expressly discloses how to use carbaryl as an insecticide in order to meet the statutory requirements for patentability, it cannot properly be said there is "no disclosed relationship" between the product carbaryl and its disclosed use as an insecticide. Nor can it be correctly said that the product carbaryl is "unconnected in design, operation or effect" with its use to kill insects. Thus it is clear that the restriction requirement which was imposed on the first application lacked authority under 35 USC 121 because that application did not claim "two or more independent and distinct inventions".

It is believed that the claims as presented are in condition for allowance. The Examiner is invited to contact the undersigned at 703-418-2777, if she feels that further discussion may facilitate the resolution of any outstanding issues.

An early indication of a Notice of Allowance is earnestly solicited.

Respectfully submitted,

  
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